

REMARKS

Drawing Objections

Applicants submit amended Figures 1 and 3, wherein the reference number 40 has been deleted. Marked versions of these Figures showing the changes are attached. These amendments are believed to fully address the Examiner's objection to the drawings.

Specification Objections

Applicants have amended the paragraph beginning on or about line 16 of page 6 of the specification to correct the typographical error relating to the reference number of the pins, per the Examiner's suggestion. In addition, Applicants have corrected two other minor typographical errors in that paragraph. All of these amendments are supported by the application, and do not introduce new matter. These amendments are believed to fully address the Examiner's objection to the specification.

Allowed Claims

Applicants note with appreciation that claims 14-15 and 29-30 are indicated as allowed. As such, these claims are not discussed further herein.

Claim Rejection Under §112

Applicants have amended claim 13 to better indicate that the saw blade of the second configuration is the same saw blade as the first configuration, as suggested by the Examiner. This amendment is fully supported by the specification, does not narrow

the claims, and does not raise any new issue. This amendment is believed to fully address the Examiner's §112 issue, and withdrawal of the rejection is therefore respectfully requested.

Claim Rejections Under §§102-103

The Examiner rejects independent claim 12 under §102 over Duffy. Applicants respectfully request reconsideration.

The Examiner asserts that Duffy shows that connection points 40a and 42a are disposed on an arc circumscribing the first blade-engaging element 35. In support of this, the Examiner supplies Exhibit B. The Examiner further points to Figure 1 of the present application and, in essence, asserts that the Duffy pins 40a and 42a are as close to the arc line as pins 26 are in Applicant's Figure 1. Applicants respectfully submit that this rationale is both legally and factually incorrect.

First, Applicants point out that the relevant claim language is "with said swing arm in said extended position thereof, said second and third blade-engaging elements are commonly disposed on an arc circumscribing said first blade-engaging element." This claim language is supported, *inter alia*, by the specification page 9, lines 11-15, reading "the coplanar pins 26 extending from either the surfaces 22 or the surfaces 24 of the lobe 20 and the end piece 34 lie on a common arc, the center point of which is the pin 26 on the corresponding coplanar surface (22 or 24) of the coupling block 52. That arrangement ensures facile conversion between the two configurations of the saw...." Applicants respectfully submit that the pins 26 are shown as being disposed on the arc of Figure 1, at least within drafting tolerance. Further, the Examiner's attention

is directed to the drawings originally filed with the parent application (application 09/839,195, now U.S. Patent No. 6,606,795), copies of which are attached, which clearly show the arc touching the pins. The Examiner should note that the parent application was incorporated into the present application by reference.

The Examiner supplies Exhibit B in support of the Examiner's assertion that Duffy shows pin 42a disposed on the same arc as pin 40a. An necessary predicate for the Examiner's assertion is that the relevant pins in the Duffy figures are in their precise scaled positions in the figures. This, in turn, necessarily requires that the Duffy figures be drawn to scale. However, Duffy's figures are not drawn to scale, and the Examiner is legally unable to assume that they are. MPEP §2125 plainly indicates that the Examiner cannot assume patent drawings to be drawn to scale. One this point, the Examiner's attention is also directed to *Hockerson-Halberstadt, Inc. v. Avia Group Int'l.*, 222 F.3d 951, 55 U.S.P.Q.2d 1487 (Fed. Cir. 2000). There is absolutely nothing in Duffy that indicates that the Duffy drawings are drawn to scale, nor has the Examiner even attempted to point to anything in Duffy that supports a contrary conclusion. As such, the Examiner's assumption that the Duffy drawings are to scale is legally impermissible. If the Duffy figures are not drawn to scale, then any attempt to argue that the pin locations in the Duffy figures necessarily show the relevant pins lying on an arc is impossible to make. And, without such a showing, the Examiner's argument must fail.

Further, even assuming *arguendo* that the Duffy drawings are drawn to scale, Examiner's Exhibit B plainly shows that location of pin 42a (the pin on short swing arm 42), when swing arm 42 is in the extended position, is noticeably and significantly

farther away from arc A than the pin 40a on long swing arm 40. Indeed, the Examiner's Exhibit B shows arc A passing through the middle of pin 40a, but being well away from pin 42a. By rough estimation, the gap between 42a and arc A of Exhibit B is approximately 5% of the entire distance from pin 35 to pin 40a. No one of ordinary skill in the art of saws of the claimed character would construe Exhibit B to be showing pin 42a as being on, or even, as a practical matter, close to, arc A. Thus, even setting aside the legally improper basis for the Examiner's reliance on the Duffy figures, the resulting Exhibit B refutes the Examiner's position.

Thus, in view of the above, Applicants submit that the basis put forth by the Examiner for rejecting claim 12 under §102, as it relates to the claimed pin locations in relation to the arc, is both legally and factually improper. Accordingly, Applicants submit that claim 12 defines patentable subject matter over the cited art.

Separately, Applicants note that claim 12 requires, *inter alia*, "an elongate, substantially rigid back member," that includes the third blade-engaging element. In rejecting claim 1, the Examiner asserts that the back member 15 of Duffy somehow includes swing arm 42. Applicants submit that such a construction of Duffy is at odds with how one of ordinary skill in the art would interpret Duffy. Duffy itself plainly distinguishes between its "upper leg portion 15" and the various rigid fingers 40,41,42. Thus, Duffy shows that one of ordinary skill in the art would not consider the fingers 40,41,42 to be part of the hacksaw frame's back, but that such fingers are distinct elements that are not part of the back. More importantly, Duffy fundamentally requires the fingers 40,41,42 to be pivotally mounted to the end of the upper leg 15. Duffy, col. 2, lines 42-49 ("a distal member 36 rigidly affixed (as by welding) to the front end of

upper leg 15 includes a pair of side plate portions 36a,36b, ... A bolt 37 extends through the side plate portions and pivots supports a plurality (three are shown at 40,41 and 42) of rigid fingers, with bolt 37 being retained by nut 38. The three pivotable fingers...") (emphasis added). Thus, Duffy absolutely requires that the fingers be pivotally joined to the back. If, as the Examiner suggests, the Duffy fingers and back are somehow merged into one element, the presence of this free pivot fundamentally renders the relevant configuration of the structure incapable of being "substantially rigid" as required by the claims. In short, something with a free pivot in its middle is not rigid; it is instead inherently flexible. Yes, the respective segments may be themselves rigid, but the overall structure is not, nor would one of ordinary skill in the art consider them to be. Thus, even if the Duffy fingers and back are somehow merged into one element, the resulting structure simply does not satisfy the express limitation of "an elongate, substantially rigid back member." Accordingly, Duffy cannot anticipate the subject matter of claim 12.

In view of the above, Applicants submit that the Examiner has failed to put forth a legally proper *prima facie* case for anticipation of claim 12 under §102. Accordingly, Applicants submit that independent claim 12, and its dependent claims 13, 17-27, 31-32 define patentable subject matter over the cited art.

The Examiner has also rejected dependent claims 16 and 28 under §103 over Duffy, sometimes in combination with Keymer. A review of the Examiner's rationale for the §103 rejections finds that Duffy is the primary reference relied on, and that the rejections necessarily rest on the same misconstruction of Duffy as put forth for the

§102 rejections. As pointed out above, the Examiner's assertions with respect to Duffy on the pins/arc location and the rigid back are legally impermissible and/or factually incorrect. As such, Applicants submit that the Examiner has failed to put forth a legally proper *prima facie* case for obviousness of claims 16, 28 under §103. Accordingly, Applicants submit that dependent claims 16,28 define patentable subject matter over the cited art.

Respectfully submitted,


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Dated: March 17, 2005